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Intellectual Property Causes
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2834

Attorney Docket No. P21361

In re application of Hiroshi NAKATSUKA et al.

Serial No. : 09/930,184

Box Non-Fee

Group Art Unit : 2834

Filed : August 16, 2001

Examiner : Jaydi A. Aguirrechea

For : METHOD OF DRIVING A PIEZOELECTRIC TRANSFORMER AND POWER SOURCE
APATHIES USING THE SAME

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Sir:

Transmitted herewith is an Election with Traverse in the above-captioned application.

- ___ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a verified statement previously filed.
___ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
___ An Information Disclosure Statement, PTO Form 1449, and references cited.
X No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 30	*30	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 6	**6	0	x 42=	\$	x 84=	\$0.00
Multiple Dependent Claims Presented			+140=	\$	+280=	\$0.00
Extension Fees for Month				\$		\$0.00
Total:				\$	Total:	\$0.00

*If less than 20, write 20

**If less than 3, write 3

___ Please charge my Deposit Account No. 19-0089 in the amount of \$____.

N/A A Check in the amount of \$____ to cover the filing/extension fee is included.X The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.X Any additional filing fees required under 37 C.F.R. 1.16.X Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3).

Bruce H. Bernstein
Reg. No. 29,027



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants : Hiroshi NAKATSUKA et al.

Group Art Unit: 2834

Appln. No. : 09/930,184

Examiner: Jaydi A. Aguirrechea

Filed : August 16, 2001

For : METHOD OF DRIVING A PIEZOELECTRIC TRANSFORMER AND
POWER SOURCE APPARATUS USING THE SAME

ELECTION WITH TRAVERSE

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Official Action of November 4, 2002, in which a one-month shortened statutory period for response was set to expire on December 4, 2002, Applicants hereby elect Group I that includes claims 1, 5, 6, 8-10, and 13-16. The above election is made with traverse for the reasons set forth below.

REMARKS

Upon entry of the present paper, Applicants will have elected, with traverse, Group I that includes claims 1, 5, 6, 8-10, and 13-16. In the Official Action, the Examiner required an election of one of three inventions. The Examiner indicated that the three inventions were:

Group I - Claims 1, 5-6, 8-9, 10 and 13-16, which are drawn to piezoelectric elements and devices, which is classified in class 310, subclass 318;

Group II - Claims 2-3, 11, 17-19, 21, 23, 25, 27 and 29, which are drawn to piezoelectric elements and devices, which is classified in class 310, subclass 318; and

Group III -Claims 4, 7, 12, 20, 22, 24, 26, 28 and 30, which are drawn to piezoelectric elements and devices, which is classified in class 310, subclass 318.

The Examiner further indicated that inventions II and I were related as combination and subcombination and inventions II and III were related as combination and subcombination.

Applicants respectfully traverse the above Restriction Requirement and submit that it is inappropriate. Applicants submit that all claims currently pending in the application are directed toward a method of driving a piezoelectric transformer and a power source with a piezoelectric transformer.

The Examiner has failed to properly set forth the two way distinctness required by MPEP 806.05(c) for combination and subcombination restrictions.

For restriction to be proper in a combination/subcombination situation, the Examiner must show that a combination, as claimed, does not require the particulars of the subcombination, as claimed, for patentability (to show novelty and unobviousness), and the subcombination can be shown to have utility either by itself or in other different combinations. The MPEP states that when these factors cannot be shown, such inventions are not distinct. In the present application the Examiner has not addressed the second requirement.

Applicants assert that although the various claims recite different arrangements, this alone is an inadequate basis to consider there are multiple inventions that are properly restrictable for examination purposes. For example, independent claim 1 of group I, independent claim 2 of group II, and independent claim 4 of group III all recite two method steps of "detecting ..." a value and "controlling the driving frequency..." It is unclear how these two steps in each of the groups can be considered a combination or subcombination of the others.

Additionally, the search field for the identified groups is coextensive. Although there may be specific search areas that are required for particular claims that are not

P21361.A03

required for others, this alone is believed to be inadequate and thus an inappropriate basis for requiring restriction.

Moreover, the Restriction Requirement set forth by the Examiner omits one of the two criteria for a proper Restriction Requirement now established by the U.S. Patent and Trademark Office policy. As set forth in MPEP § 803 "an appropriate explanation" must be set forth by the Examiner as to the existence of a "serious burden" if the Restriction Requirement were not required. By virtue of the Examiner's requirement indicating the same classification and since the claims of the three groups are so closely related, it is submitted that there is no serious burden on the Examiner in examining all these claims together. Given their relationship, the search for all the claims includes a significant amount of overlap.

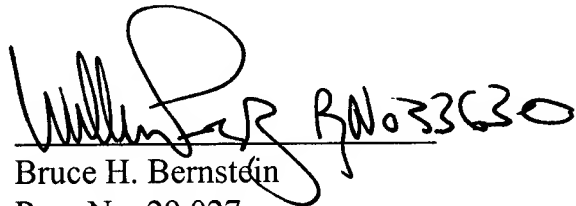
For all of these reasons, and consistent with the Office Policy as set forth in MPEP § 803, Applicants respectfully request that the Examiner reconsider the position taken in the above-mentioned Official Action and withdraw the Restriction Requirement in the present application. Accordingly, the Examiner's Restriction Requirement is believed to be improper and has been traversed for the reasons set forth above.

Nevertheless, in order to be fully responsive, Applicants have elected with traverse the invention of Group I that includes claims 1, 5, 6, 8-10, and 13-16 in the event that the Examiner chooses not to reconsider and withdraw the Restriction Requirement.

P21361.A03

Should the Examiner have any questions or comments regarding the present response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Hiroshi NAKATSUKA et al.


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Reg. No. 29,027

December 3, 2002
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